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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,091	08/28/2003	Asta Khavakh	N0172 US	7735

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NAVIGATION TECHNOLOGIES
222 MERCHANDISE MART
SUITE 900, PATENT DEPT.
CHICAGO, IL 60654

EXAMINER

NGUYEN, THU V

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,091

Applicant(s)

KHAVAKH ET AL.

Examiner

Thu Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/28/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

The response to the election/restriction requirement filed on July 26, 2004 is acknowledged. By the response, the invention group I (claims 24, 31-40) has been elected. Claims 24, 31-40 are now pending in the application.

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 24 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,298,303. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 31-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,298,303 (patent '303 hereinafter) in view of claims 2-9 of US patent No. 6,678,611 (patent '611 hereinafter).

Claims 2-9 of patent '611 disclose the same subject matter of claims 31-38 of the present application. Claim 1 of patent '303 discloses traffic weighting of claims 39. Moreover, obtaining traffic weighting information from a traffic monitoring device would have been well known. Since patent '303 teaches using search tree data structure for selecting road segment

records, building a search tree taught in patent '303 with the structure taught in claims 2-9 of patent '611 would have been obvious to facilitate searching and selecting suitable route segments.

Drawings

5. The fig.18 is objected to, specifically, misspelling "seed ate 108" should be corrected to "seed gate 108". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 24, 31-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 24, line 12, the claimed “said road segments” lacks of antecedent basis (because the “road segments” is different from the “road segments *records*”).
Further, the claimed limitation is ambiguous because line 3 teaches all the “road segment *records*” stored in a database; moreover, line 9 seems to teach the “road segment records” that has been optimally selected. It is not clear if the claimed limitation in line 12 implies the “road segment records” stored in the database, or if it implies the selected road segment records taught in line 9.
- b. Other claims are rejected as being dependent on the rejected base claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 24, 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagyu et al (US 5,899,955) in view of Nomura (US 6,751,609).

As per claim 24, 33, 39, Yagyu teaches a method of providing route navigation, the method comprises the steps of calculating a solution route between a first location and a second location including a list of road segments (col.8, lines 53-67; col.9, lines 22-53; col.14, lines 4-10) by forming at least one search tree (starting point (fig.6B)) (col.10, lines 52-67; col.12, lines 30-40) formed of a plurality of gates (n3-n6) (fig.8A) representing a physical location on the road network; identifying to which of the road segment the weighting (shortest time) is applied (col.12, lines 30-40, lines 64-67); growing a search tree (col.10, lines 62-67; col.11, lines 1-10), moreover, incrementing the search node and evaluating the successor node for traversing all the node in a search tree would have been well known. Yagyu does not teach traffic weighted and including accessible direction relative to the physical location. However, using traffic condition as a weighted component in selecting optimal route would have been well known. Further, Nomura suggests including accessible direction relative to the physical location to the road segment records (col.10, lines 41-54). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include road segment accessible information taught by Nomura and the known traffic condition to the system of Yagyu in order to facilitate selecting optimal accessible road segments with minimum time resources.

As per claim 31, Yagyu teaches referring to a segment database ID (n1, n2, etc. in fig.4B).

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As per claim 32, 34, identifying a node in a tree data structure with a pointer, including reference to a predecessor node in a tree which is actually just a link list of nodes would have been well known.

As per claim 35-38, 40, Yagyu teaches augmenting an inbound search tree (at the destination tree) with a search tree that formed part of the solution route (col.11, lines 11-23). Further, maintaining calculated information in a memory, providing the user with navigation guidance using the solution route, prompting the user to indicate whether a new route should be calculated upon departing from the route solution, and using traffic monitoring service to obtain traffic weightings would have been well known.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for formal communications intended for entry)

Or:

(703) 305-7687 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park V, 2451
Crystal Drive, Arlington. VA., Seventh Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Thu Nguyen whose telephone number is (703) 306-9130. The
examiner can normally be reached on Monday-Thursday from 8:00 am to 6:00 pm ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Thomas Black, can be reached on (703) 305-8233. The fax phone number for this
Group is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 308-1111.



THU V. NGUYEN
PRIMARY EXAMINER

September 6, 2004